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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,899	08/31/2000	Fred Alan Bishop	10655.8000	3558

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AMERICAN EXPRESS COMPANY
C/O MCDERMOTT WILL & EMERY LLP
227 WEST MONROE STREET, SUITE 4400
CHICAGO, IL 60606-5096

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/652,899	Applicant(s) BISHOP ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 43-46 and 90-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 43-46, and 90-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed May 29, 2007. Claims 1, 43, 90, and 98 were amended. Claims 1-4, 43-46, and 90-103 are pending.

Response to Arguments

2. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1, 2, 43, 44 and 90 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7171662 to Misra et al. ("Misra").

Referring to claim 1, Misra discloses receiving at a first server (i.e. license server), a transaction request from a merchant server, issuing a challenge to a second server (i.e. intermediate server) and forwarding the challenge from said second server to the user, receiving said response at said second server from the user based upon said challenge, processing said response at said second server to verify the intelligent token assembling credentials (see fig. 6, lines 15-29), for the transaction at said first server, said credentials comprising at least one key (i.e. the license encrypted with a key), providing at least a portion of said assembled credentials

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to said user (see abstract, col. 15, lines 32 & 33), receiving, at said second server, a second request from said user, said second request including said portion of said assembled credentials provided to said user, wherein said challenge is passed to an intelligent token (i.e. client) for processing said challenge, wherein said intelligent token generates a response to said challenge (see col. 4, lines 60, 61 and col. 5, lines 24-35) and validating, at said second server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service (see col. 14, lines 17-23).

Referring to claims 2 and 44, Misra discloses the method wherein the transaction is an electronic purchase transaction (see abstract).

Claim 43 is a method for conducting a transaction, which performs the steps of method claim 1 above; therefore, this claim is rejected on the same rationale as claim 1.

Claim 90 is a method for conducting a transaction, which performs the steps of method claim 1 above; therefore, this claim is rejected on the same rationale as claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 45 rejected under 35 U.S.C. 103(a) as being unpatentable over Misra as applied to claim 2 above, and further in view of Linehan.

Referring to claim 3, Misra discloses the electronic purchase transaction (see claim 2 above). Misra does not expressly disclose the electronic purchase transaction is conducted using

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a digital wallet. Linehan discloses performing an electronic purchase transaction using a digital wallet (see col. 4, lines 10-23). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method disclose by Misra to include a digital wallet. One of ordinary skill in the art would have been motivated to do this because digital wallets provides piracy by encrypting user personal information.

Claim 45 is rejected on the same rationale as claim 3 above.

7. Claims 4, 46, 91- 93, 96-98, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra as applied to claims 1 and 90 above, and further in view of U.S. Patent No. 6873974 to Schutzer.

Referring to claims 4, 96 and 101, Misra discloses an intelligent token (see claim 1 above – the client). Misra does not expressly disclose the intelligent token is a smart card. Schutzer discloses the intelligent token is a smart card (see col. 9, lines 16-24). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Misra to include an intelligent token that is a smart card. One of ordinary skill in the art would have been motivated to do this because smart cards are more secure than software wallets and they can be conveniently carried as the user roams.

Referring to claim 46, Misra discloses a user conducts a transaction via a wallet (see claim 43 above). Misra does not expressly disclose the user conducts the transaction via a smart card. Schutzer discloses the user conducts the transaction via a smart card (see col. 9, lines 16-24). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Misra to include the step wherein the user conducts the transaction via a smart card. One of ordinary skill in the art would have been

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motivated to do this because smart cards are more secure than software wallets and they can be conveniently carried as the user roams.

Referring to claim 91, Misra discloses a user, and second server (see claim 90 above). Misra does not expressly disclose accessing required information associated with said user from said second server, populating one or more corresponding user purchase forms at said second server with said required information and said second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completion of said transaction. Schutzer discloses accessing required information associated with said user from said second server, populating one or more corresponding user purchase forms at said second server with said required information and said second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completion of said transaction (see col. 2, lines 15-27). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Misra to include the steps of accessing required information associated with said user from said second server, populating one or more corresponding user purchase forms at said second server with said required information and said second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completion of said transaction. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system that allows users to easily interact with merchants.

Referring to claims 92, Misra discloses the transaction is an electronic purchase transaction (see abstract).

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Referring to claim 93, Misra discloses the electronic purchase transaction using the Internet (see claim 91 above). Misra does not expressly disclose the transaction is a web-based purchase transaction. Schutzer discloses the transaction is a web-based purchase transaction (see abstract). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method disclose by Misra to include a web-based purchase transaction. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system that allows users to easily interact with merchants.

Referring to claims 97 and 103, Misra discloses an electronic transaction system (see claim 91 above). Misra does not expressly disclose said required information includes user name, user address, shipping address, card number and payment amount. Schutzer disclose said required information includes user name, user address, shipping address, card number and payment amount (see abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose Misra to include said required information includes user name, user address, shipping address, card number and payment amount. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system that allows users to easily interact with merchants.

As per claim 98, this claim is rejected on the rationale of claims 90 and 91 above.

8. Claims 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra and Schutzer as applied to claim 91 above, and further in view of Linehan.

Misra discloses the electronic purchase transaction (see claim 2 above). Misra does not expressly disclose the electronic purchase transaction is conducted using a digital wallet.

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Linehan discloses performing an electronic purchase transaction using a digital wallet (see col. 4, lines 10-23). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method disclose by Misra to include a digital wallet. One of ordinary skill in the art would have been motivated to do this because digital wallets provides piracy by encrypting user personal information.

9. Claims 100 and 102 rejected under 35 U.S.C. 103(a) as being unpatentable over Misra and Schutzer as applied to claim 98 above, and further in view of Linehan.

Misra discloses the electronic purchase transaction (see claim 98 above). Misra does not expressly disclose the electronic purchase transaction is conducted using a digital wallet.

Linehan discloses performing an electronic purchase transaction using a digital wallet (see col. 4, lines 10-23). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method disclose by Misra to include a digital wallet. One of ordinary skill in the art would have been motivated to do this because digital wallets provides piracy by encrypting user personal information.

10. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misra and Schutzer as applied to claim 98 above, and further in view of Kausik et al. ("Kausik").

Misra discloses receiving said challenge at said intelligent token (i.e. the client – see claim 98 above). Misra does not expressly disclose said intelligent token promoting said user for a personal identifier, receiving said personal identifier from said user, said intelligent token validating said personal identifier and unlocking said instrument. Kausik discloses receiving said personal identifier (i.e. PIN) from said user, said instrument validating said personal identifier sand unlocking said instrument (see col. 5, lines 10- 24, the user enters a PIN to unlock the

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wallet...the PIN is compared with a stored hash value...if the two hash values agree, the PIN is passed to decryption module...the decrypted private key is released for use), said intelligent token transmitting said response to said first server (see claim 30 (c)). As for the step of said intelligent token prompting said user for a personal identifier this is an inherent step. That is, before the user enters the PIN, he must have previously been prompted for such entry. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method disclose by Misra to include the steps of promoting said user for a personal identifier, receiving said personal identifier from said user, said intelligent token validating said personal identifier and unlocking said instrument. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of security and protection for all entities involved in the transaction (see col. 7, lines 3-5 & 33-38 of Kausik).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

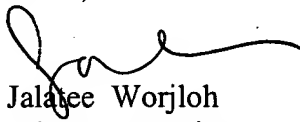
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jalatee Worjloh
Primary Examiner
Art Unit 3621

June 25, 2007